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PATENT APPLICATION

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

ATTORNEY DOCKET NO. ___10991381-1___

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Masumi Senoo**

Application No.: **09/506,407**

Filing Date: **Feb. 17, 2000**

Confirmation No.: **7749**

Examiner: **Saeld Ebrahiml Dehkordy**

Group Art Unit: **2625**

Title: **Configurable Printer Menu Structure**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on ___4/21/2006___.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Date of facsimile: June 21, 2006
Typed Name: Joanna Keyt
Signature:

Respectfully submitted,
Masumi Senoo

By

Steven R. Ormiston

Attorney/Agent for Applicant(s)

Reg No. : 35,974

Date : June 21, 2006

Telephone : (208)433-1991

Rev 10/05 (ReplyBrf)

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Rev 10-03 (ReplyBrf)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/506,407
Filing Date ....February 17, 2000
Inventor...Senoo et al.
Group Art Unit.. 2625
Examiner ....Ebrahimi-Dehkordy Saeid
Attorney's Docket No. 10991381-1
Confirmation No. 7749
Title: Configurable Printer Menu Structure

ANOTHER REPLY BRIEF
(Responding to the Examiner's Answer/Response Mailed April 21, 2006)

<u>Status of the Appeal and Request for Decision by the Board</u>

 1. Applicants file Opening Brief on May 23, 2005.

 2. In response, the Examiner mails a non-final Office Action on August 11, 2005 purporting to reopen prosecution and advancing new grounds for rejection.

 3. In reply, the Applicants file a Reply Brief on October 11, 2005 requesting that the appeal be maintained under Rule 41.39(b)(1) and responding to the new grounds for rejection.

 4. In response, the Examiner mails an "Examiner's Answer" on May 21, 2006 "in response to the appeal brief filed 5/23/05" even though the paper actually responds to the Applicants' arguments in the Reply Brief (addressing the new grounds for rejection set forth in the Action mailed August 11, 2005).

 The timing and substance of the "Office Action" mailed August 8, 2005 is consistent with an examiner's answer provided for under Rule 41.39(a) that includes a new ground

for rejection. The timing and substance of the "Examiner's Answer" mailed May 21, 2006 is consistent with a supplemental examiner's answer provided for under Rule 41.43(a). Accordingly, Applicants are filing Another Reply Brief as provided for under Rule 41.43(b).

Consistent with the rules, therefore, Applicants request that the appeal now pass immediately to the Board for decision.

Selecting Menu Options Is Not The Same As Creating A Menu Structure

Claim 1 recites creating a printer menu structure and installing the printer menu structure on an erasable storage device in a printer. A user makes selections from options presented through a menu structure. As detailed in Applicants' first Reply Brief, Ta teaches assembling printing menu selections to form a final set of printing instructions for a print job. Selecting options from a menu structure is not the same as creating the menu structure itself. As stated in the Background section of the Application at page 1, lines 13-17:

> "The menu structure provides the functions necessary to control or manage the operation of the printer. The user navigates the menu structure be pressing one or more buttons to select the desired menu operation (such as resetting the printer, initiating a form feed operation, or selecting a particular font or template)."

The Examiner asserts at page 7 of the Answer that "Ta clearly teaches assembling printers option menu selecting menu structures [sic] (column 3 lines 30-32)" and that "This reads on creating a printer menu structure by actually selecting the desired options from the P setup menu and creating a new printer menu." In fact, the cited passage in Ta teaches "an apparatus for assembling printing option menu selections to form a final set of printing instructions...." There is nothing in this passage that even remotely suggests "creating a new menu structure" or "creating a new printer menu." With all due respect, the Examiner's assertion to the contrary is plainly wrong.

Sending Print Menu Selections To The Printer Is Not The Same As Installing A Menu Structure On The Printer

The Examiner asserts at page 7 of the Answer that "Ta clearly teaches creating features (or structures) comprised of various printer options, and then loading the menu

09/506,407
Docket No. 10991381-1
Appellants' Reply Brief
Page 2

PAGE 4/5 * RCVD AT 6/21/2006 3:20:08 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/0 * DNIS:2738300 * CSID:208 433 9295 * DURATION (mm-ss):01-44

into the printer (column 7 lines 45 to column 8, line 35)." In fact, the cited passage in Ta teaches that the "PC setup menu *selections*" are sent to the printer "coupled with the print job interface code" or stored on a "diskette or other portable electronic storage media." Ta column 8, lines 2-5 and lines 15-20(emphasis added). If stored on a diskette, then "[o]nce printing the job is initiated, the job (with the embedded PC setup menu) is loaded *selections* [sic] into the printer by inserting the diskette into a printer disk drive." Ta column 8, lines 31-34 (emphasis added). It is readily apparent that the word "selections" in Ta column 8, line 32 is in the wrong place -- the passage should read "the job (with the embedded PC setup menu selections) is loaded into the printer...."

There is nothing in the cited passages in Ta that teach or even suggest installing a menu structure on the printer. Rather, these passages clearly teach sending menu selections to the printer as part of the print job. The Examiner's assertion to the contrary is not correct.[1]

Respectfully submitted,

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[1] The text in Ta immediately following that cited by the Examiner also supports the Applicants' position: "In differing embodiments of the present invention, the printer setup menu options of block 208 may include each of the PC setup menu options of block 104 of FIG. 2, some of the PC setup menu options, or even some menu choices not found in the PC setup menu options. Once the printer menu option *selections* are made, (or even if no changes are made according to decision block 214), the various job files to which the printer setup menu is to be applied are selected, according to block 212. In other embodiments of the present invention, the print job(s) to which printer setup menu options are to be applied may be selected before the printer setup menu option *selections* are made (such as may be illustrated by placing block 212 of FIG. 2 between blocks 202 and 204)." Ta column 8, lines 41-54 (emphasis added).